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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,005	02/17/2004	Frank M. Simonutti	WG0057H	9568

7590 12/09/2008  
Terence P. O'Brien  
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8700 W. Bryn Mawr Avenue  
Chicago, IL 60631

EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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12/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* FRANK SIMONUTTI and ROBERT THURMAN

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Application No. 10/780,005  
Technology Center 3700

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Mailed: December 9, 2008

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Before TOI JOHNSON *Review Paralegal*  
JOHNSON, *Review Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on December 2, 2008. A review of the application revealed that it is not ready for docketing as an appeal.

Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER  
INCONSISTENCIES WITH THE  
FINAL REJECTION OF RECORD

A review of the file finds inconsistencies between the last rejection of record and corresponding sections of the Examiner's Answer as set forth below.

Final Rejection

A review of the Final Rejection (Office Action Summary) mailed on March 27, 2008, finds the following status of the claims: claims cancelled: 3, 4, 6, 7, 9, 14-17, 20-27, 31, 35 and 43-56, claims allowed: NONE, claims rejected: 1, 2, 5, 8, 10-13, 18, 19, 28-30, 32-34, 36, 37, 41, 42 and 57-68 and claims withdrawn: NONE. However, claim 58 is not included for review in the body of the Final Rejection.

Examiner's Answer

On July 18, 2008, the Examiner mailed an Examiner's Answer in response to Appellants' Brief. Further review of the Examiner's Answer reveals that claim 58 is not included in any statement of rejection for review by the Board of Patent Appeals and Interferences.

It should be noted that claim 58 is identified as being on appeal in the Appeal Brief filed June 23, 2008.

Clarification of claim 58 is required in the Examiner's Answer.

Grounds of Rejection

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed July 18, 2008 under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds a new Ground of Rejection that has not been provided the required heading "New Grounds of Rejection" and which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner's Answer sets forth a rejection of claims 33 and 34 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan in view of Statz and Yamada further in view of Yamagishi; whereas the last Office action finds that claims 33 and 34 are rejected under

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35 U.S.C. 103(a) as being unpatentable over Sullivan in view of Sullivan and Yamada further in view of Yamagishi. Correction of all Grounds of rejection for all claims is required.

### CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) vacate the Examiner's Answer mailed July 18, 2008;
- 2) generate a new Examiner's Answer that address claim 58 and to clarify the grounds of rejection for claim 33 and 34 as may be required;
- 3) include the necessary approval from the TC Director or designee in accordance with MPEP 1207.05, part (B) as may be required for any new grounds of rejection noted above; and
- 4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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